

Claims 1-20 were rejected as being obvious over Takeuchi in view of Ross '375. Claims 8 and 17 were rejected as being obvious over Takeuchi in view of Ross '375 and Okumura. Claims 1-20 were rejected for obviousness-type double patenting over claims 1-20 of Chen in view of Ross '375. These rejections are respectfully traversed and should be withdrawn because Ross '375 is *not* prior art. Mr. Qixu (David) Chen, one of the named inventors on this application, herewith submits a sworn Declaration under 37 CFR 1.131 antedating Ross '375.

37 CFR 1.131(b) states the following:

(b) The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior date to said date to a subsequent reduction to practice or to the filing of the application.

Mr. Chen's Declaration shows *actual* reduction to practice prior to the effective date of Ross '375. Actual reduction to practice occurs when an inventor builds an embodiment of the invention as claimed in a patent claim and tests it to determine that it will be operable in its intended functional setting. *Kimberly-Clark Corp. v. Johnson & Johnson*, 745 F.2d 1437, 1445, 233 USPQ 603, 607 (Fed. Cir. 1984). An embodiment must be evaluated under either actual working conditions or conditions that sufficiently simulate working conditions. *Paivinen v. Sands*, 339 F.2d 217, 144 USPQ 1 (CCPA 1964).

Note that it is not necessary "that the entire claimed invention must be shown [in the Rule 131 Declaration] in all cases except the genus-species situation. ... The primary consideration is whether, in addition to showing what the reference shows, the affidavit also establishes possession of either the whole invention claimed or something falling within the claim, in the sense that the claim as a whole reads on it." *In re Tanczyn*, 347 F.2d 832, 146 USPQ 298 (CCPA 1965). The disc whose raw XRD data are shown in Exhibit 1 attached to Mr. Chen's Declaration is the *same disc* whose XRD and TEM data are shown in Figures 3 and 6 of the specification. Figures 3 and 6 show that *this disc worked for its intended purpose*, i.e., as a recording medium.

Therefore, Mr. Chen's Declaration establishes possession of the whole invention claimed because once the invention has been shown to work for its intended purpose, reduction to practice is complete. *Mahurkar v. C. R. Bard, Inc.*, 79 F.3d 1572, 1578, 38 USPQ2d 1288, 1291 (Fed. Cir. 1996).

Claims 7, 16 and 19 have been canceled and new claims 21-23 have been added. In new claims 21-23, the limitation that the sealing layer has *a thickness of about 450Å or less* is supported by the disclosure on page 12, line 5, in Figures 4 and 5, and on page 17, lines 12-14, of the specification. Note that an invention such as that of Ross, whose objective is laser texturing a NiP or NiNb layer, would require a thick layer of NiNb to form texture bumps "having a height of 20 to 30 nm," i.e., 200 to 300Å. See column 7, lines 31 and 32, of Ross '373. In fact, *the minimum thickness of NiNb layer disclosed in Ross '375 is 50 nm, i.e., 500Å*. See column 7, line 28, of Ross '375.

In light of the above, a Notice of Allowance is respectfully solicited.

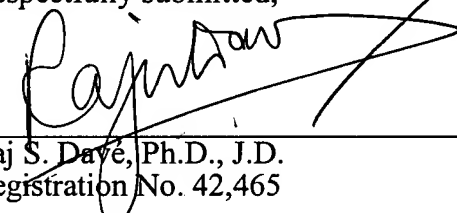
Attached hereto is a marked-up version of the changes made to the claims by this amendment. The attached pages are captioned "Version with markings to show changes made."

In the event that the transmittal letter is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952, referencing docket number 14671-20004.00. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Respectfully submitted,

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